

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOACHIM SUESS and GERHARD ZINNER

Appeal No. 95-3303
Application No. 07/960,892¹

HEARD: April 9, 1999

Before JOHN D. SMITH, PAK and KRATZ, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 11 and 13-21. Claim 12 stands withdrawn from further consideration and appellants have withdrawn the appeal of claim 11. See the brief at page 1. Claim 13 is representative and is reproduced below:

¹ Application for patent filed October 14, 1992.

Appeal No. 95-3303
Application No. 07/960,892

13. A method of marking a surface, which comprises:

forming at least two layers of differently-colored
lacquer on a carrier;

transferring said layers of differently-colored lacquer
to said surface; and

exposing region-wise said layer of colored lacquer remote
from said surface to laser radiation to thereby expose said
layer of colored lacquer proximate said surface thereby
producing said marking on said surface.

The references of record now relied upon by the examiner
are:

Van Paesschen et al. (Van Paesschen)	3,650,740	Mar.
21, 1972		
Magden et al. (Magden)	3,794,544	Feb. 26,
1974		
Glaser et al. (Glaser)	3,926,707	Dec. 16,
1975		
Oka et al. (Oka)	3,930,924	Jan. 6,
1976		
Holbein et al (Holbein)	4,732,410	Mar. 22,
1988		
Takii et al. (Takii)	4,968,526	Nov. 6,
1990		

The appealed claims stand rejected under 35 U.S.C. § 103
as follows:

1) claims 13, 17-19, and 21 as unpatentable over admitted
prior art in view of Van Paesschen;

Appeal No. 95-3303
Application No. 07/960,892

2) claim 13 as unpatentable over admitted prior art in view of Oka;

3) claims 13 and 17 over admitted prior art in view of Magden;

4) claims 17-19 and 21 as unpatentable over admitted prior art in view of Oka or Magden further in view of Van Paesschen;

5) claim 20 as unpatentable over admitted prior art in view of Van Paesschen, Oka, or Magden further in view of Glaser;

6) claims 14 and 15 over admitted prior art and the "secondary references" as in rejections 1), 2), and 3) above, further in view of Holbein; and

7) claims 14 and 16 over admitted prior art and the "secondary references" as in rejections 1), 2), and 3) above, further in view of Takii.

The subject matter on appeal is directed to a method of laser marking a surface (e.g., a front plate of a piece of equipment) wherein at least first and second differently-colored layers of colored laquer are first formed on a carrier from which they are subsequently transferred to the surface. At this point in the process, the top layer of colored laquer (i.e., the colored laquer layer "remote from the surface") is "region-wise" exposed to laser radiation to thereby expose a

bottom layer (i.e., a layer of colored lacquer "proximate to the surface") thereby producing a marking on the surface. In prior art processes, "conventionally applied layers of lacquer" are said to "suffer from variations in thickness" so that under some circumstances in which the outer layer is relatively thick, it is incompletely removed (specification, page 2, lines 9-14). To remedy this problem, the laser power may be increased, but this often has the adverse effect of damaging or completely removing the bottom (underneath) lacquer layer (specification, page 2, lines 14-22). To solve the thickness variation problem, appellants form both colored lacquer layers on a carrier and then transfer the layers to the desired surface (in a manner similar to applying a decal to a surface) for subsequent laser marking. Prior art workers were apparently aware of the need to apply at least the outer layer as uniformly as possible (specification, page 2, lines 29-32). However, the "conventional"² application techniques resulted in considerable increases in the cost of marking a

² In the record before us, the examiner has made no factual findings regarding what specific "conventional" application techniques are utilized in the prior art processes.

surface of an article (specification, page 3, lines 1-5).
Thus, only "expensive or high-quality equipment" was marked.

As evidence of obviousness of the claimed method, the examiner has relied upon the "admitted prior art" in view of a multiplicity³ of "secondary references" which show that, inter alia, "transfer" is one of a "variety of well known application procedures" (answer, page 9, last paragraph). We agree with appellants, however, that just because the prior art indicates that "the process of transferring multilayer coatings from a temporary support to a permanent support" is known "for general use" (answer, page 4, lines 5-7), is no suggestion to the skilled artisan to employ this technique in a process as claimed. Significantly, the examiner refers to no disclosure in the applied references as teaching that a "transfer" technique has a known advantage of producing uniformly thick colored layers on a permanent support in a

³ We are reminded of the statement of the court in Ball & Roller Bearing Co. v. F.C. Sanford Mfg. Co., 297 F.163, 167(2d Cir. 1924) that "One good reference is better than 50 poor ones, and the 50 do not make the one any better." With respect to the multiple stated rejections in the present appeal, compare Ex parte Blanc, 13 USPQ2d 1383, 1384 (Bd. Pat. App. & Int. 1989).

Appeal No. 95-3303
Application No. 07/960,892

highly economical manner. Accordingly, the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. We, therefore, reverse the stated rejections of the appealed claims.

OTHER ISSUES

With respect to prior art methods of producing laser markings on a surface, appellants refer to EP 0 393 956 A1 as a relevant reference. See the specification at page 1, lines 28-34. Apparently, appellants intended to refer to EP 0 383 956 A1, instead. The U.S. equivalent of the latter mentioned reference is U.S. Patent 4,901,089 issued to Bricot on February 13, 1990, copy attached. This reference should be carefully reviewed by the examiner prior to passing this application to issue. In this regard, note that Bricot at column 2, lines 25-27 describes the deposition of ink layers by such techniques as "photoengraving, smooth cutting, offset or other type of method."

The decision of the examiner is reversed.

REVERSED

Appeal No. 95-3303
Application No. 07/960,892

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

jrg

Appeal No. 95-3303
Application No. 07/960,892

MARN & ASSOCIATES
489 Aurora Place
Brick, NJ 08723